

### **REMARKS**

In the Office Action mailed September 10, 2009 from the United States Patent and Trademark Office, claims 1-7, 9, 11, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,332,149 to Warmus et al. (hereinafter “Warmus”) in view of U.S. Patent No. 5,664,178 to Sinofsky (hereinafter “Sinofsky”) and U.S. Patent 5,181,162 to Smith et al. (hereinafter “Smith”), claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Simpson, Sinofsky, and Smith further in view of U.S. Patent No. 7,215,434 to Janse et al. (hereinafter “Janse”), claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Sinofsky, Smith and U.S. Patent No. 7,196,803 to Simpson et al. (hereinafter “Simpson”), further in view of allegedly well known prior art, claims 13, 15, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus in view of U.S. Patent No. 7,102,767 to Wu et al. (hereinafter “Wu”) and U.S. Patent No. 6,326,983 to Venable et al. (hereinafter “Venable”), claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Wu, and Venable in view of Smith, claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Wu and Venable in view of allegedly well known prior art, claims 19, 20 and 22-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Simpson, Sinofsky, and Venable, and claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Warmus, Simpson, Sinofsky, and Venable in view of Smith. Applicant respectfully provides the following:

#### **Rejections under 35 U.S.C. § 103(a):**

In response to Applicant’s prior amendments and remarks, the prior rejections were withdrawn, and new art (Smith, Wu, and Venable) was cited in new and modified rejections.

Specifically, the Office Action proposes to add Smith to the combination of references (Warmus, Simpson, and Sinofsky) used to reject independent claim 1, to add Wu and Venable to references (Warmus) previously cited in rejecting independent claim 13, and to add Venable to previously cited references (Warmus, Simpson, and Sinofsky) to reject independent claim 19. Applicant respectfully traverses the rejections as follows:

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) In showing that one of ordinary skill in the art would have found it obvious to combine the teachings of multiple references, it is improper to combine references where the references teach away from their combination. M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein.

Applicant also respectfully submits that one of skill in the art would not have found it obvious to combine the cited references in the manner proposed in the Office Action to arrive at the claimed invention. Applicant therefore submits that the Office Action has failed to show how one of skill in the art would have found it obvious to overcome the differences between the prior art and the claimed invention to arrive at the claimed invention.

**Independent Claim 1:**

With respect to independent claim 1, the Office Action proposes to add Smith to the previously-cited art (Warmus, Simpson, and Sinofsky). Applicant respectfully submits that the proposed combination is improper. Applicant further submits that even if the combination is proper, the proposed combination still fails to teach all elements of claim 1.

The Office Action proposes that one of skill in the art would find it obvious to combine Sinofsky with Warmus and Simpson, thus providing one comprehensive file with the motivation “to maintain the integrity of the comprehensive file.” This motivation has not changed since the last Office Action. The rejection then proposes to add Smith to the combination. Smith, however, explicitly teaches maintaining separate components of a document as “discrete units” accessed selectively (Col. 2 lines 40-42) using a database management system (Col. 2 lines 54-58). Indeed, Smith teaches that it is a specific object of the Smith system to store document components in this way. (Col. 2 line 40) Smith specifically teaches against systems such as disclosed and relied on in Sinofsky, explaining that such systems require elaborate file structures and do not address the difficult aspects of document creation addressed in Smith. (See Col. 1 lines 41-59.) Thus, Smith teaches against any proposed combination that uses the single file teachings of Sinofsky, and any proposed combination containing Smith and relying on

Sinofsky's single file teachings is improper. See M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Even if the proposed combination were proper, Applicant respectfully submits that the combination does not teach every element of claim 1. Claim 1 recites that “the rendering device: receives the single file in the native format; and renders the single file, wherein the one or more sub-images are rendered as parts of the one or more pages of the document based on an association process, wherein the association process is one of (i) an overlay process, (ii) an underlay process, and (iii) a composite process, and wherein the second sub-image is rendered as a part of the first sub-image which is rendered as a part of one of the pages of the document.”

The Office Action has not shown that one of skill in the art would find it obvious to combine the references in such a way as to overcome the differences between the references and to have a rendering device render the single file in the manner claimed. Smith is relied upon for teaching the claim elements of rendering a second sub-image as part of a first sub-image which is rendered as part of one of the pages of the document. However, as discussed above, Smith does not utilize a single file of the type claimed, and the Office Action does not show that one of skill in the art would find it obvious to utilize the complex database management system of Smith in a rendering device as claimed or that one of skill in the art would find it obvious to overcome the differences between the claimed invention and the cited references.

Therefore, for at least these reasons, claim 1 cannot be said to be made obvious by the proposed combination of references.

**Independent Claim 13:**

With respect to independent claim 13, the Office Action proposes to add Wu and Venable to the previously-cited art (Warmus). Applicant submits that the proposed combination of references does not teach every element of the claims.

The Office Action acknowledges that Warmus does not disclose using electronic tags of a TIFF document file (see Office Action, page 10, approximately  $\frac{2}{3}$  down the page) and then proposes to add Venable, alleging that Venable teaches using electronic tags of a TIFF document file (without referencing any part of Venable) and merging sub-images based on the electronic tags of the TIFF document file. Applicant respectfully disagrees with this characterization of Venable. Although Venable discusses “tags” in SIDL (Structured Image Definition Language), those tags are not electronic tags of a TIFF document file as claimed. Indeed, Venable specifically teaches that the SI files are “text file[s] containing pointers to component objects,” (Col. 2 lines 31-32, emphasis added) (not TIFF files) and that “an SI does not store the rasters of the component objects within the SI file.” (Col. 2 lines 36-37) Therefore, the SI file of Venable does not equate with a TIFF document file containing multiple sub-images of a TIFF image as required by claim 13. Indeed, the very portion of Venable cited in the office action specifically discloses: “Notice that path1, path2, and path4 all refer to raster, text or graphic files. Path3 refers to another SID file that creates a raster image from combining a graphical tree with a raster image of a house.” (Col. 14 lines 1-5)

Therefore, Venable cannot be said to teach using electronic tags of a TIFF document to perform one of the functions recited in claim 13. In addition, Applicant respectfully submits that the proposed combination of references fail to teach the claimed elements in relation to a single TIFF document file. Warmus teaches separate master page files and variable page files (see

Figure 5), and Venable also teaches separate files as discussed above (path1, path2, path3, and path4 all refer to different files to be merged as directed by the SI). (Col. 14 lines 1-5)

Therefore, for at least these reasons, the proposed combination fails to teach all elements of independent claim 13, and the Office Action fails to show how one of skill in the art would have found it obvious to overcome the differences between the cited references and the claimed invention. Claim 13 is therefore not made obvious by the cited references.

**Independent Claim 19:**

With respect to independent claim 19, the Office Action proposes to add Venable to the previously-cited references (Warmus, Simpson, and Sinofsky). Applicant respectfully submits that the combination proposed is improper for reasons similar to those discussed above.

The Office Action proposes that one of skill in the art would find it obvious to combine Sinofsky with Warmus and Simpson, thus providing one comprehensive file with the motivation “to maintain the integrity of the comprehensive file.” This motivation has not changed since the last Office Action. The Office Action proposes to add Venable to this combination for its teachings with respect to electronic tags, alleging that one of skill in the art would have been motivated to make the combination to utilize a format that has minimal memory requirements but produces high resolution, high quality printed images.

In making this proposed combination, however, the Office Action neglects the specific teachings of Venable that achieve this proposed benefit, which is that the Structured Image (SI) format disclosed in Venable achieves the low-memory benefits through the use of a structure that maintains the various image components in different files, in direct contrast with the purpose of combining the teachings of Sinofsky cited in the Office Action of maintaining all elements in a single file. Indeed, Venable specifically states that it is an object of the Venable invention to

maintain the image elements separately from the file containing the SI file containing the tags.

Venable states: “It is still another object of [SI] to store imagery as a text file containing pointers to component objects. Output rasters are not generated until required for display or printing.

Therefore, hundreds of versions of an SI can exist in the amount of disk space required typically by one raster image. Since an SI does not store the rasters of the component objects within the SI file, the user of archival imagery such as clip art, for example, becomes much more efficient as only one copy of the source is required.” (Col. 2 lines 31-39, emphasis added)

Thus, the benefit of Venable that is proposed as the motivating factor for the combination of Venable’s teachings of electronic tags with Warmus, Simpson, and Sinofsky is only obtained in Venable by way of keeping the components of Venable’s rasters as separate files. Indeed, the portion of Venable cited in the rejection specifically mentions the presence of the various files. (Col. 14, lines 1-5: path1-path4 refer to separate files) Thus, Venable teaches against any proposed combination that uses the single file teachings of Sinofsky, and any proposed combination containing Venable and relying on Sinofsky’s single file teachings is improper. See M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Therefore, the proposed combination of references is improper, and claim 19 is not made obvious thereby.

Applicant also respectfully maintains that one of skill in the art would not find it obvious to combine Warmus and Sinofsky in the manner suggested for the reasons that have been previously addressed.

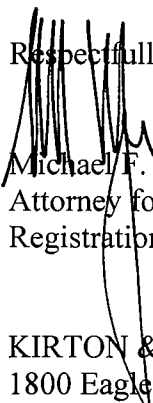
For at least the above reasons, Applicant respectfully requests removal of all rejections under 35 U.S.C. § 103(a).

**CONCLUSION**

Applicant submits that any amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 7 day of December, 2009.

Respectfully submitted,

  
Michael F. Krieger  
Attorney for Applicant  
Registration No.: 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Facsimile: (801) 321-4893



**GENERAL TRANSMITTAL LETTER (FOR BOTH SMALL AND LARGE ENTITIES)**

Applicant(s): Andrew R. Ferlitsch  
Docket No.: 10237.32  
Application No.: 10/676,984  
Filing Date: September 30, 2003  
Examiner: Peter K. Huntsinger  
Customer No.: 21,999  
Group Art Unit: 2625  
Confirmation No.: 7696


Invention: SYSTEMS AND METHDOS FOR PROVIDING PRINTING WITH  
DOCUMENT INDICIA

COMMISSIONER FOR PATENTS

√ The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 500843

√ Any additional filing fees required under 37 C.F.R. 1.16.

√ Any patent application processing fees under 37 CFR 1.17.

  
\_\_\_\_\_  
Signature

Dated: December 7, 2009

Michael F. Krieger  
Attorney for Applicant  
Reg. No.: 35,232  
KIRTON & McCONKIE  
60 East South Temple, Suite 1800  
Salt Lake City, UT 84111  
Telephone: (801) 321-4814  
Fax: (801) 321-4893